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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,895	11/30/2001	Joan C. Teng	21756-013000	4164

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TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER
8TH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

RUTLEDGE, AMELIA L

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/998,895

Applicant(s)

TENG ET AL.

Examiner

Amelia Rutledge

Art Unit

2176

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Heather Herndon AR
Heather R. Herndon
Supervisory Patent Examiner
Technology Center 2100

Continuation of 11. does NOT place the application in condition for allowance because:

1. Applicant's arguments filed 09/19/2006 have been fully considered but they are not persuasive. Applicant argues against the rejections under 35 U.S.C. 101 (claims 1-11, 13-21, 23-31 and 33-36) by citing Annex II of the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility (hereinafter "Guidelines") (Remarks, p. 10-11). However, Annex II refers to "a claim limited to a machine or manufacture...". While applicant argues that independent claims 1 and 14 recite a specific machine because claims 1 and 14 recite "an identity system" (Remarks, p. 11, par. 2), it is the examiner's opinion that the recitation of an identity system, especially for claim 1, is not sufficient to limit the rejected claims to "a machine or manufacture", since a system could be interpreted to mean an abstract construct of organization, for example.

2. In the Final Office Action mailed 07/20/2006, claims 1, 2-11, and 34-36 were additionally rejected for being non-statutory because they were not recorded on a computer-readable medium. Applicant argues that the rejection seems to suggest that a method or process cannot be patentable subject matter unless it is embodied on a computer-readable medium (Remarks, p. 11, par. 4). However, MPEP 2106 cites that "claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute 'descriptive material.'" Further, Annex IV of the Guidelines describes computer-related nonstatutory subject matter, for example Warmerdam, 33 F.3d at 1361 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory), stating that in order to be statutory functional descriptive material must be recorded on some computer readable medium to become structurally and functionally interrelated to the medium (Guidelines p. 50).

3. Applicant argues that independent claims 1 and 14 recite in part "performing a first workflow for said task to affect the target identity profile" and argues that this limitation would provide a practical application since it recites transformation of the target identity profile to a different state (Remarks, p. 11, par. 3). However, it is the examiner's opinion that although the workflow as claimed may affect the target identity profile, as claimed, in the knowledge generally known in the art at the time of the invention, the term "affect" would not have been equivalent in meaning to "a transformation of an article...to a different state", contrary to applicant's arguments, and therefore is not sufficient to provide a practical application. Affecting the profile would not result in a practical application.

4. In response to applicant's argument that there is no suggestion to combine the references (Remarks, p. 12), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Du and SiteMinder are analogous art, since both are directed toward policy and identity management. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply SiteMinder to Du, so that Du would have the benefit of a policy server which would integrate applications and improve workflow by integrating directories and external databases in its policies so that legacy applications and systems could still be used (SiteMinder, p. 22-23, last paragraph). Therefore, the motivation may be found within SiteMinder, p. 22-23, last paragraph.

5. In response to applicant's arguments against the references individually (Remarks, p. 13-14), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).